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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,538	07/28/2003	David A. Martin	22467.23743	3543
78340 7590 12/22/2008 Emerson, Thomson & Bennett, LLC 777 W. Market Street Akron, OH 44303			EXAMINER RAJ, RAJIV J	
			ART UNIT 3686	PAPER NUMBER
			MAIL DATE 12/22/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/628,538

Applicant(s)

MARTIN ET AL.

Examiner

RAJIV J. RAJ

Art Unit

3686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23 and 35-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on 02 October 2008.
2. Claims 23, 36, and 37-39 have been amended.
3. Claims 1-22 and 24-34 have been canceled.
4. Claims 23 and 35-39 are currently pending and have been examined.

Priority

5. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Double Patenting

6. The Double Patenting rejection is withdrawn in response to Applicant's intent to "file a terminal disclaimer if the prior art rejections are overcome."

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. In light of Application's remarks, the rejection, under 35 USC § 102 is withdrawn.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 23 and 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (US 5664109) (hereinafter Johnson) in view of Newman et al. (US 6035276) (hereinafter Newman).

12. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference

as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim 23

Johnson as shown, discloses the following limitations:

- *transferring information from the medical malpractice insurance policy to the credentialing questionnaire; (see at least Johnson Fig:1,2, 7 & related text)*
- *credentialing questionnaire to an associated healthcare provider for review and approval; (see at least Johnson Fig:8 Items:802-810 & related text)*

Johnson does not disclose the following limitations, however Newman, as shown does:

- *forwarding the credentialing questionnaire; (see at least Newman Column:5 Lines:10-16)*

It would have been obvious to one of ordinary skill in the art to add the feature of Newman into Johnson. One of ordinary skill in the art would have added this feature into Johnson with the motivation to provide a more efficient and effective method and system for populating, managing, and transmitting medical and insurance questionnaire information. (see at least Newman Column:2 Lines:28-61)

Claim 35

The combination of Johnson/Newman disclose all of the limitations of claim 23. Johnson further discloses the following limitation:

- *providing at least one blank space on the questionnaire where information from the insurance policy does not match with at least one question on the questionnaire; (see at least Johnson Column:12 Lines:42-50 Fig:6 Items:610-614, 630-634 & related text)*

Johnson/Newman does not disclose the following limitations, however Newman, as shown does:

- *requesting information from the healthcare provider to fill in the at least one blank space (see at least Newman Column: 3 Lines:64-67 Column:4 Lines:1-15)*

It would have been obvious to one of ordinary skill in the art to add the feature of Newman into Johnson/Newman. One of ordinary skill in the art would have added this feature into Johnson/Newman with the motivation to provide a more efficient and effective method and system for populating, managing, and transmitting medical and insurance questionnaire information. (see at least Newman Column:2 Lines:28-61)

Claim 36

The combination of Johnson/Newman disclose all of the limitations of claim 23. Johnson further discloses the following limitation:

- *forwarding the completed questionnaire to an associated credentialing entity (see at least Johnson Column:10 Lines:30-36)*

Claim 37

Johnson as shown, discloses the following limitations:

- *means for transferring information from the medical malpractice insurance policy to the credentialing questionnaire; (see at least Johnson Fig:1,2, 7 & related text)*
- *credentialing questionnaire to an associated healthcare provider for review and approval; (see at least Johnson Fig:8 Items:802-810 & related text)*

Johnson does not disclose the following limitations, however Newman, as shown does:

- *means for forwarding the credentialing questionnaire; (see at least Newman Column:5 Lines:10-16)*

It would have been obvious to one of ordinary skill in the art to add the feature of Newman into Johnson. One of ordinary skill in the art would have added this feature into Johnson with the motivation to provide a more efficient and effective method and system for populating, managing, and transmitting medical and insurance questionnaire information. (see at least Newman Column:2 Lines:28-61)

Claim 38

The combination of Johnson/Newman disclose all of the limitations of claim 37. Johnson further discloses the following limitation:

- *means for providing at least one blank space on the questionnaire where information from the insurance policy does not match with at least one question on the questionnaire; (see at least Johnson Column:12 Lines:42-50 Fig:6 Items:610-614, 630-634 & related text)*

Johnson/Newman does not disclose the following limitations, however Newman, as shown does:

- *means for requesting information from the healthcare provider to fill in the at least one blank space* (see at least Newman Column: 3 Lines:64-67 Column:4 Lines:1-15)

It would have been obvious to one of ordinary skill in the art to add the feature of Newman into Johnson/Newman. One of ordinary skill in the art would have added this feature into Johnson/Newman with the motivation to provide a more efficient and effective method and system for populating, managing, and transmitting medical and insurance questionnaire information. (see at least Newman Column:2 Lines:28-61)

Claim 39

The combination of Johnson/Newman disclose all of the limitations of claim 37. Johnson further discloses the following limitation:

- *means for forwarding the completed questionnaire to an associated credentialing entity* (see at least Johnson Column:10 Lines:30-36)

Response to Arguments

14. Applicant's arguments with respect to claim 23 and 35-39 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Rajiv J. Raj** whose telephone number is **(571) 270-3930**. The Examiner can normally be reached on Monday-Friday, 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Jerry O'Connor** can be reached at **571.272.6787**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to **(571) 273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

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Alexandria, VA 22314.

Rajiv Raj /RJR/
Patent Examiner, Art Unit 3686
December 18, 2008

/Gerald J. O'Connor/
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